Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY M. WIELAND and BLAINE L. WIELAND

Appeal No. 2000-0322
Application No. 08/855,921

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 7, mailed July 2, 1998) of claims 1, 3, 6-8, 11-23 and 25. Claims 4, 5, 10 and 24 were indicated to be rejected on the summary page of the final rejection, however, no rejection of claims 4, 5, 10 and 24 was included in the final rejection. Accordingly, claims 4, 5, 10 and 24 are not before us in this appeal and the status of those claims is unclear from the record. Claims 2 and 9 have been canceled.

We REVERSE and REMAND.

## BACKGROUND

The appellants' invention relates generally to furniture and the packaging of furniture for shipment and storage (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Christian | 2,692,007 | Oct. 19, 1954 |
| Dunbar et al. (Dunbar) | 3,458,966 | Aug. 5, 1969 |
| Wilson | 3,540,776 | Nov. 17, 1970 |
| Zur | 4,078,842 | Mar. 14, 1978 |
| Bubien | 4,881,779 | Nov. 21, 1989 |

Claims 1, 3, 6-8, 15-18, 20 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bubien in view of Dunbar.

Claims 11-14 and 21-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bubien in view of Dunbar as applied to claims 8 and 20 above, and further in view of Wilson and Zur.

Claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bubien in view of Dunbar as applied to claim 8 above, and further in view of Christian.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and the answer (Paper No. 14, mailed March 11, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed December 30, 1998) for the appellants' arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3, 6-8, 11-23 and 25 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The examiner's answer (p. 3) maintains the rejection of all the independent claims on appeal (i.e., claims 1, 8 and 20) under 35 U.S.C. § 103 as being unpatentable over Bubien in view of Dunbar for the reasons set forth in the final rejection (pp. 2-3). In the final rejection, the examiner determined that

(1) Bubien teaches a ready-to-assemble article of furniture comprising an unassembled frame for the article of furniture, padding which is adapted to form a cushion for the article of furniture, reducing the volume of the padding and packaging the reduced volume padding; (2) the only difference between the claimed subject matter and Bubien being that Bubien does not teach that the volume of the padding is reduced by vacuum and compression packing; (3) Dunbar teaches vacuum and compression packing of foam or open celled material that is used in furniture construction; and (4) it would have been obvious and well within the level of ordinary skill in the art to modify the article of furniture, as taught by Bubien, to include vacuumed and compressed packed foam material, as taught by Dunbar.

The appellants argue (brief, pp. 12-15) that the applied prior art does not suggest the claimed subject matter. The appellants state that Bubien fails to disclose that for which it was cited by the examiner. The appellants then specifically point out that Bubien fails to disclose or suggest reducing the volume of the padding or any of the furniture cushions.

The examiner responded (answer, p. 4) to the above-noted argument of the appellants by admitting that there is "no mention of reducing the volume of the padded surfaces [in Bubien]." Nevertheless, the examiner then concludes that this "does not mean that some cramming or squeezing of the padded surfaces, which would result in a reduced volume of the padded surfaces, was not needed."

All the claims under appeal recite in one manner or another reduced volume padding. However, this limitation is not suggested by the applied prior art. In that regard, we agree with the appellants that there is no teaching or suggestion in Bubien of reducing the volume of his padding or

any of his furniture cushions. Additionally, none of the other applied prior art would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Bubien to reduce the volume of his padding or any of his furniture cushions when the furniture is in the container mode shown in Figure 1.

In our view, the only suggestion for modifying Bubien in the manner proposed by the examiner to include reduced volume padding stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1, 3, 6-8, 11-23 and 25.

REMAND

This application is remanded to the examiner for consideration of a further search of the claimed subject matter.

The claimed subject matter is directed to a ready-to-assemble article of furniture, a method for packaging a ready-to-assemble article of furniture, and a method of assembling a ready-to-assemble article of furniture. In our view, the claimed subject matter may be taught or suggested from the waterbed art[1] and/or the futon art[2] classified in Class 5, BEDS.

Accordingly, we remand this application to the examiner to consider a search of Class 5 and any other pertinent field of search.

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[1] See, for example, U.S. Patent Nos. 5,564,141; 5,115,526; 4,788,727; 4,575,886; and 4,521,928.

[2] See, for example, U.S. Patent Nos. 6,000,079 and 4,928,337.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 6-8, 11-23 and 25 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

REVERSED; REMANDED

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| IAN A. CALVERT<br>Administrative Patent Judge | ) |
| NEAL E. ABRAMS<br>Administrative Patent Judge | ) BOARD OF PATENT APPEALS AND INTERFERENCES |
| JEFFREY V. NASE<br>Administrative Patent Judge | ) |

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